

### **REMARKS/ARGUMENTS**

This is in response to the Office Action dated May 14, 2008. Claims 1-22 are pending for further examination.

#### **Section 112 Rejections**

Claims 8-11 and 19-20 stand rejected under 35 U.S.C. § 112, first and second paragraphs. These Section 112 rejections are respectfully traversed for at least the following reasons.

The legal test for enablement under Section 112, first paragraph, is whether one of ordinary skill in the art could make and use the invention, without undue experimentation, and the legal test for adequate written description under Section 112, second paragraph, is whether the claims contain subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors were in possession of the invention as the time of the application was filed. Applicant notes that a description as filed is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption. *See, e.g., In re Marzocchi*, 439 F.2d 220, 224 (CCPA 1971); MPEP 2163.04. Thus, the PTO has the initial burden of presenting evidence or reasoning to explain why persons skilled in the art would not recognize in the original disclosure a description of the invention defined by the claims. *See In re Wertheim*, 541 F.2d 257, 263 (CCPA 1976). Importantly, it is also noted that the subject matter of the claim need not be described literally for the disclosure to satisfy the description requirement. *See* MPEP 2163.02.

In this case, the instant specification explains in paragraph [0049] that a bush test involved using a dry brush for an abrasion test where the dry brush is used to rub the coated sheet in order to simulate a situation where water was unexpectedly cut off in a coated sheet

washer. Moreover, the specification explains in paragraph [0049] that a glove mar test is an abrasion test using a rubbing material similar to that commonly used in gloves of glass handlers. These tests are thus defined in the specification, and the use of “brush test” and “glove mar test” in these claims is both clear and definite. Significantly, the brush used is compliant with DIN 53 778, emphasizing that it is known to those skilled in the art.

Furthermore, with respect to the allegations made in the Office Action regarding the use of “relative terms,” Applicant respectfully notes that the fact that claim language that includes terms of degree that may not be precise does not automatically render the claim indefinite under 35 U.S.C. § 112, second paragraph. *See Seattle Box Co., v. Industrial Crating & Packing, Inc.*, 731 F.2d 818 (Fed. Cir. 1984); MPEP 2173.05(b). Rather, the acceptability of the claim language depends on whether one of ordinary skill in the art would understand what is claimed, in light of the specification.

In this case, even aside from the information available to one of ordinary skill in the art, the instant specification explains in paragraph [0049] and shows visually in Fig. 6, for example, what is being used as for baseline measurement, how differences in degree are defined, and even provides various example differences. From such descriptions and visual depictions, one of ordinary skill in the art certainly would be able to make and use the invention defined by the claims, and could certainly do so without undue experimentation. Thus, there can be no doubt that the claims are enabled.

Although not applicable to analysis under Section 112, page 10 of the Office Action includes the (erroneous) allegation that “the claims at issue appear to be statements of intended use. . . .” Intended use has nothing to do with whether a claim is enabled or definite. Notwithstanding this *non sequitur*, it is hard to imagine how a recitation of scratch resistance

relates to how an article will be used. Such recitations clearly relate to the structural properties of the article produced by the claimed method and thus are not in any way statements of intended use.

For at least the foregoing reasons, Applicant respectfully submits that all outstanding Section 112 issues have been addressed and are resolved. Thus, reconsideration and withdrawal of the outstanding rejections are respectfully requested.

Claims 1 and 12

Claim 1 stands rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Stachowiak (U.S. Patent No. 6,602,608) in view of both Medwick (U.S. Patent No. 6,682,773) and Konda (U.S. Patent No. 5,254,201). This three-way Section 103(a) rejection is respectfully traversed for at least the following reasons.

The Office Action still contends that it would have been obvious to have modified Stachowiak by provide a protective coating thereon as taught by Medwick. However, even if Stachowiak is modified by applying to it the protective coating of Medwick (which Applicant does not agree with, in any event), the resulting modified product still would not meet the invention of claim 1. In particular, the resulting combination product still would not have a protective coating applied “in non-liquid form” and which is removed by “peeling” as required by claim 1. Instead, as explained in paragraph [0014] of the instant specification, Medwick’s coating is a reaction product applied in liquid form. Moreover, Medwick’s reaction product coating cannot be removed by peeling, and requires much more complicated and undesirable steps. Thus, even the proposed modification to Stachowiak in view of Medwick would not meet the invention of claim 1 for at least these several reasons. It is respectfully noted that these are deficiencies of the alleged combination (as well as with the references individually).

The Office Action further contends that it would have been obvious to have used the solid film of Konda in Stachowiak/Medwick. This contention is incorrect and is respectfully traversed for at least the following reasons. Konda discloses a conductive wafer-protective sheet that is used to protect semiconductor wafers from static electricity. In this regard, Konda requires that the protective sheet is electrically *conductive*, so that it can protect the *semiconductor wafer from static electricity* (e.g., col. 2, lines 55-58; col. 4, lines 6-15). In contrast, there is no static electricity problem in the alleged Stachowiak/Medwick combination. Moreover, there is no semiconductor wafer to protect in the Stachowiak/Medwick combination. Because Stachowiak has no semiconductor wafer to protect, and there is no problem with static electricity in Stachowiak, there is no reason why one of ordinary skill in the art would have ever used Konda's conductive wafer-protective sheet in the device of Stachowiak. Additionally, there is no reason why one of ordinary skill would ever want a conductive protective sheet to be present in the alleged Stachowiak/Medwick combination, given that this could be damaging and destroy the product during glass processing such as cutting and scoring. One of ordinary skill at the time of the invention would not have used a conductive coating in a coated glass application. Thus, it will be appreciated that there is no suggestion or motivation in the cited art for the alleged modification of Stachowiak based on Konda.

In a nutshell, Applicant notes that (1) the alleged Stachowiak/Medwick combination and Konda belong in entirely different fields of endeavor and are non-analogous art (i.e., *inter alia*, coated articles are markedly different from semiconductor wafers), (2) the alleged Stachowiak/Medwick combination does not suffer from the same or similar problems and, thus, the "problem" advanced in the Office Action does not exist and does not need to be solved, and (3) combining the references in the manner alleged in the Office Action runs again the

conventional wisdom of that which was known in the art at the time of the invention, namely, with respect to the use and non-use of a conductive coating in a coated glass application. Surely, such would argue against the “mere substitution” of one film for another, when such films are used in fundamentally different applications and are fundamentally different in their own right, and where the underlying motivation is fundamentally flawed. Hindsight is not permitted. Accordingly, Applicant respectfully submits that one of ordinary skill in the art at the time of the invention would not have been motivated to combine the Konda with the alleged Stachowiak/Medwick combination.

The above three-way Section 103(a) is incorrect for at least the reasons discussed above. Similar arguments apply to independent claim 12. Thus, this rejection should be withdrawn as to all pending claims 1-22.

Claims 8-11 and 19-20

Page 7 of the Office Action makes a number of incorrect arguments with respect to claims 8-11 and 19-20. The Office Action first states that “absent any compelling evidence to the contrary, . . . application of the Konda protective sheet to the Stachowiak Low-E glass substrate . . . would inherently yield Applicants [sic] claimed enhanced resistance to scratching via either the glove mar test and/or the abrasion bursh tests.” Applicant notes that with respect to inherency rejections, the law is clear that for something to be “inherent” in a reference, it must “necessarily” be present. *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). The fact that a certain result or characteristic “may” occur or be present in the prior art is not sufficient to establish the inherence of that result of characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). The Board of Appeals has made clear that “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact

and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The Office Action has not demonstrated that the application of Konda’s protective sheet to Stachowiak’s Low-E glass substrate must necessarily yield Applicant’s specifically claimed enhanced resistance to scratching. The mere possibility of some enhanced scratch resistance simply is not sufficient as a matter of law to establish that “application of the Konda protective sheet to the Stachowiak Low-E glass substrate . . . would inherently yield Applicants [sic] claimed enhanced resistance to scratching via either the glove mar test and/or the abrasion bursh tests,” as alleged in the Office Action. Thus, this statement is flawed as a matter of patent law. Hindsight is not permitted.

The Office Action next argues that Applicant’s claimed “scratch performance” would have been obvious through mere routine experimentation and optimization of the protective sheet thickness. Aside from the fact that the Office Action has failed to establish that an analogous protective film ever is applied to an analogous coated article, and aside from the fact that the Office Action has failed to establish that protective sheet thickness is outcome determinative with respect to scratch resistance beyond merely alleging that such is the case, the Office Action apparently misses or ignores the fact that the claims require the scratch resistance to be increased after the protective film is peeled off. Indeed, such “reasoning” overlooks at least paragraph [0032] of the instant specification, which states that “surprisingly and unexpectedly, it has been found that the protective layer provides added durability/protection even after it is removed,” and gives reasons for why this might be the case. Thus, the Office Action’s “reasoning” is completely inapposite to the specifically claimed increases in scratch resistance that occur after the protective film is removed. Accordingly, even this further alternative reason fails to make up

for the lack of any teachings or suggestions directed to the specifically claimed increases to scratch resistance. Again, hindsight is not permitted.

In view of the above, Applicant respectfully submits that claims 8-11 and 19-20 should be allowable for at least these additional reasons.

Claims 21-22

In the context of claims 21-22, page 8 of the Office Action properly notes that “none of the cited prior art references explicitly limit the substrate temperature to fall between 60-120°C or 90-120°C as required in the respectively identified claims.” However, the Office Action goes on to incorrectly argue that such substrate temperature ranges “would have been derived by the skilled practitioner through no more than routine experimentation and optimization of the prior art disclosed process.” A number of deficiencies of the “prior art disclosed process” have been demonstrated above. Additionally, the mere recognition of an advantage or benefit -- in this case, “the benefit to applying the protective sheet in as expedient a timeframe as possible after formation of the Low-E coating” (which is not required in any event) -- is no substitute for clearly articulated reasoning as to why such a modification would have been made by one of ordinary skill in the art at the time of the invention. In other words, although one of ordinary skill in the art might possibly have applied “the protective sheet in as expedient a timeframe as possible after formation of the Low-E coating,” such is (1) irrelevant to the specifically claim temperature ranges, and (2) no substitute for the factual findings necessary to support the legal conclusion of obviousness. The “reasoning” included in the Office Action also misses or ignores Applicant’s finding, expressed at paragraph [0038] of the instant specification, for example, that such temperature ranges are needed because the coated sheet is at an elevated temperature due to

the coater used to apply the low-E coating on the substrate. Once more, hindsight is not permitted.

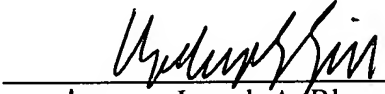

In view of the above, Applicant respectfully submits that claims 21-22 should be allowable for at least these additional reasons.

Conclusion

It is respectfully requested that all rejections be withdrawn. All claims are in condition for allowance.

Respectfully submitted,

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